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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,111	02/10/2004	Richard Heller	1372.30.DIV	2110
21901	7590	02/23/2007		
SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR, FL 34677			EXAMINER STIGELL, THEODORE J	
			ART UNIT	PAPER NUMBER
			3763	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

517

Office Action Summary	Application No.	Applicant(s)	
	10/708,111	HELLER ET AL.	
	Examiner	Art Unit	
	Theodore J. Stigell	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/20/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 2 and 11 are objected to because of the following informalities: Please delete "an" in the first line of claim 2 to correct a minor antecedent basis problem. Claim 11 does not make sense as currently recited. It appears that some words have been omitted by mistake. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Weaver (5,389,069). Weaver discloses a system for delivering a charged molecule into a cell in vivo comprising an apparatus (148) for positioning a charged molecule outside and generally adjacent the cell in vivo, an apparatus (152) for delivering a first electromagnetic pulse to the cell that could have a strength and duration insufficient to cause electroporation and sufficient to cause electromigration, and an apparatus (154) for delivering a second electromagnetic pulse that could have strength and duration to cause electroporation, wherein the pulses could have exponentially rising components,

wherein the apparatus for delivering the pulses is oppositely charged electrodes (152,154), wherein the first pulse and second pulse could have the recited field strengths recited in claims 4-6, wherein the first and second pulses could be a series of pulses, wherein the pulses have opposite polarities, wherein the molecules are injected into the area around the cell, and wherein the molecules include a plurality of different charged molecules.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Bernard (5,873,849). Bernard discloses a system for delivering a charged molecule into a cell in vivo comprising an apparatus (not numbered, column 8, lines 64-67) for positioning a charged molecule outside and generally adjacent the cell in vivo, an apparatus (a tricell) for delivering a first electromagnetic pulse to the cell that could have a strength and duration insufficient to cause electroporation and sufficient to cause electromigration, and an apparatus (another tricell) for delivering a second electromagnetic pulse that could have strength and duration to cause electroporation, wherein the pulses could have exponentially rising components, wherein the apparatus for delivering the pulses is oppositely charged electrodes (42,44), wherein the first pulse and second pulse could have the recited field strengths recited in claims 4-6 (the pulse generator used by Bernard is the Cyto Pulse 4000, which is the same one used by Applicant, therefore these pulse characteristics can surely be met), wherein the first and second apparatuses have an electrode pair with oppositely charged electrodes, wherein a third apparatus could be included (Figure 6), wherein the first and second pulses could be a series of pulses, wherein the pulses have opposite polarities, wherein the molecules are

injected into the area around the cell, and wherein the molecules include a plurality of different charged molecules.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Heller (6,135,990). Heller discloses a system for delivering a charged molecule into a cell in vivo comprising an apparatus (10) for positioning a charged molecule outside and generally adjacent the cell in vivo, an apparatus (12) for delivering a first electromagnetic pulse to the cell that could have a strength and duration insufficient to cause electroporation and sufficient to cause electromigration, and an apparatus (another 12) for delivering a second electromagnetic pulse that could have strength and duration to cause electroporation, wherein the pulses could have exponentially rising components, wherein the apparatus for delivering the pulses is oppositely charged electrodes (13,15), wherein the first pulse and second pulse could have the recited field strengths recited in claims 4-6 (the pulse generator used by Heller is the Cyto Pulse 4000, which is the same one used by Applicant, therefore these pulse characteristics can surely be met), wherein the first and second apparatuses have an electrode pair with oppositely charged electrodes, wherein a third apparatus (another 12) could be included (Figure 4), wherein the first and second pulses could be a series of pulses, wherein the pulses have opposite polarities, wherein the molecules are injected into the area around the cell, and wherein the molecules include a plurality of different charged molecules.

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it

constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Stigell whose telephone number is 571-272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/708,111
Art Unit: 3763

Page 6

Theodore J. Stigell
Theodore J. Stigell

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